UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/421,055	04/12/95	JOHNSON	N 49286USA9C

EXAMINER
WALLERSTEIN

ART UNIT	PAPER NUMBER
1301	10

12M1/0904

JAMES V. LILLY, ESQUIRE
3M OFFICE OF INTELLECTUAL
PROPERTY COUNSEL
P O BOX 33427
ST PAUL MN 55133-3427

DATE MAILED: 09/04/96

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☐ This application has been examined ☑ Responsive to communication filed on 20 MAY 96 ☑ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☑ Notice of References Cited by Examiner, PTO-892.
2. ☐ Notice of Draftsman's Patent Drawing Review, PTO-948.
3. ☐ Notice of Art Cited by Applicant, PTO-1449.
4. ☐ Notice of Informal Patent Application, PTO-152.
5. ☐ Information on How to Effect Drawing Changes, PTO-1474.
6. ☐ _____.

Part II SUMMARY OF ACTION

1. ☑ Claims 6-31 are pending in the application.
   Of the above, claims _____ are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☑ Claims 6-31 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____. has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application apppears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

PTOL-326 (Rev. 2/93)

15. The following is a quotation of the first paragraph of 35 U.S.C. § 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification is objected to under 35 U.S.C. § 112, first paragraph, as the specification, as originally filed, does not provide support for the invention as is now claimed. Specifically, there is no apparent support in the specification for the limitations in the claims now requiring (1) the dimensionally stable film to (a) control the melt-flow behavior of the melt-flowable composition; and (b) have a preselected surface topography (N.B. independent claims 6 and 28-29); and (2) the bonding of an article to the dimensionally stable film (as set forth in claim 20).

16. Claims 6-31 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification. This could be considered to be a new matter rejection.

17. Claims 14-15 and 29-31 are further rejected under 35 U.S.C. § 112, first paragraph, as the disclosure is enabling only for claims limited in accordance with the Specification at page 27 lines 10-22. Specifically, this section of the Specification

clearly indicates that, when employed as the dimensionally stable layer, the epoxy-polyester blend must be fully thermoset/ crosslinked. See M.P.E.P. §§ 706.03(n) and 706.03(z).

18. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

19. Claims 6-8, 16 and 20-26 are further rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103 as obvious over WAGNER et al (newly applied).

WAGNER et al disclose that it is known to adhere a composite tape composed of an (apparently dimensionally stable) support film coated on one side with a heat softenable adhesive to a surface of an automobile. (Fig. 3, abstract, col. 2 lines 16-19, 33-35, 43-46 and 63-67, col. 3 lines 60-64, col. 4 lines 41-47, col. 6 lines 34-38). Any differences which might possible/conceivably exist between this envisioned, claimed invention and the teachings of this reference are held/seen NOT to constitute patentable differences.

20. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that

> the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
>
> Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

21. Claims 10-13 are further rejected under 35 U.S.C. § 103 as being unpatentable over WAGNER et al in view of PLETCHER (of record - see paragraph 29 of the last Office action).

PLETCHER discloses that, in the construction of adhesive (eg. tape) composites of the type/similar those of WAGNER et al, it is known to employ as the material of construction for the backing/base layer thereof, in addition to polyurethane, polyesters (eg. mylar), polyolefins (to include foams) etc. (N.B. col. 8 lines 57-68), such that it would have been obvious to one of ordinary skill in this art to employ any of these conventional, documented backing layer materials in the invention/tape of WAGNER et al in place of the correponding, analagous support (ie backing) layer employed therein; mere substitution of one known backing material for another involved.

22. Claims 9 and 28 are further rejected under 35 U.S.C. § 103 as being unpatentable over WAGNER et al in view of SCHAPPERT et al (also newly applied).

SCHAPPERT et al disclose that epoxy-polyester blends are known to be employed as adhesives in the bonding of automobile components (abstract, col. 1 lines 10-11 and 61-68, col. 2 line 1 thru col. 3 line 8, N.B. col. 6 lines 30-41), such that it would have been obvious to one of ordinary skill in this art to employ such a conventional, documented adhesive in the invention/tape of WAGNER et al in place of the corresponding analogous adhesive employed therein; mere substitution of one known automotive adhesive for another involved.

23. Claims 17-19 and 27 are further rejected under 35 U.S.C. § 103 as being unpatentable over WAGNER et al in view of KAN.

KAN discloses that it is both known and desirable to apply a latex (which term is held/seen to encompass (latex) paint within its scope and definition) film to a plastic substrate, a reactive/chemical bond being formed between film and substrate (abstract, col. 1 lines 6-29, col. 2 lines 36-42, col. 5 lines 12-51), such that it would have bene obvious to one of ordinary skill in this art to employ such a beneficially documented procedure in conjunction with the invention of WAGNER et al (ie the exposed support layer thereof) wherein deemed appropriate.

24. Applicant's arguments with respect to claims 6-31, field 20 MAY 1996 have been considered but are deemed to be moot in view of the new grounds of rejection. The following are, however, additionally advanced: WRT the comments made at page 7 lines 6-

11, N.B. the limitations of original claims 1-5 (now cancelled) as presented.

25. Applicant's amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL.** See M.P.E.P. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

26. Any inquiry concerning this communication should be directed to J.J. GALLAGHER at telephone number (703) 308-1971.

FT6
J.J. GALLAGHER/om
August 26, 1996
8-30-96

JOHN J. GALLAGHER
PRIMARY EXAMINER
ART UNIT 131